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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,246	09/26/2001	F. William Daugherty	12000097-0006-002	8590
26263	7590	09/13/2011		
SNR DENTON US LLP P.O. BOX 061080 CHICAGO, IL 60606-1080			EXAMINER MUNSON, PATRICIA H	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 09/13/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/963,246	Applicant(s) DAUGHERTY ET AL.	
	Examiner PATRICIA MUNSON	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-17, 19 and 20 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 08 July 2011.
2. No claims have been amended.
3. Claims 1-17 and 19-20 are currently pending and have been examined.

37 CFR 1.131 Declaration

4. A declaration made by Daniel Fossner signed 5/28/2009 and filed 5/29/2009 is ineffective to overcome Chamberlain as prior art and is ineffective to overcome the previous rejections relying on Chamberlain for the following reasons.
 - A declaration under 37 CFR 1.131 to swear behind a reference must normally be signed by each applicant. There are exceptions as provided by MPEP 715.04. Applicant will need to file a petition under 37 CFR 1.183 to the Office of Petitions in order to be granted a waiver for the signature of Mr. Shapiro. If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate. See MPEP 715.04(C). Examiner notes that a declaration has been made by Daniel Fossner signed 5/28/2009 and filed 5/29/2009 as a representative of the assignee. Additionally, Applicant has submitted evidence that the second named inventor, Peter Shapiro is unavailable to sign a declaration under 37 CFR § 1.131. Yet no petition has been filed with the Office of Petitions for a waiver of his signature. Examiner is not the appropriate party to make the determination whether a waiver of signature of the unavailable inventor may be granted. The proper procedure when an original inventor is unavailable to sign a declaration under 37 CFR § 1.131 is to file a petition under 37 CFR 1.183 to the Office of Petitions. See MPEP 715.04 [R-6]. Therefore, Applicant will need to file a petition under 37 CFR 1.183 to the Office of Petitions in order to be granted a waiver for the signature of Mr. Shapiro.

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MPEP 715.04 [R-6] Where one or more of the named inventors of the subject matter of the rejected claim(s) (who had originally signed the oath or declaration for patent application under 37 CFR 1.63) is now unavailable to sign an affidavit or declaration under 37 CFR 1.131, **the affidavit or declaration under 37 CFR 1.131 may be signed by the remaining joint inventors provided a petition under 37 CFR 1.183 requesting waiver of the signature of the unavailable inventor be submitted with the affidavit or declaration under 37 CFR 1.131.** Proof that the non-signing inventor is unavailable or cannot be found similar to the proof required for a petition under 37 CFR 1.47 must be submitted with the petition under 37 CFR 1.183 (see MPEP § 409.03(d)). Petitions under 37 CFR 1.183 are decided by the Office of Petitions (see MPEP § 1002.02(b)).

- It is argued that page 1 of exhibit 1 shows conception on or before 8/31/2000. However the document itself is clearly more recent because there are newer revisions listed and because said page 1 also includes a “last modified” date of 9/12/2000. Further, the document “One-Click Details” forming part of exhibit 2 is dated as 9/14/2000 - also after the effective date of Chamberlain.
 - Further there is no explanation regarding which portions of this evidence relates to each and every claimed feature for all claims.
 - MPEP 715.07 I: “The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of **37 CFR 1.131(b)**. *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”).”
5. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Chamberlain reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).
6. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Chamberlain reference to either a constructive reduction to practice or

an actual reduction to practice. There is mention of an email to a patent attorney on 9/19/2000, but no other activity between 9/8/2000 and 9/19/2000 is noted nor is the lack of activity explained. See MPEP 715.07(a).

7. The declaration of Daniel Fossner additionally raises the following questions:

- Daniel Fossner declares he created the document filed as exhibit 1. Yet he is not an inventor. The other people involved listed on page 1 of 8 are also not listed as the inventors. Who is Donald Robinson, who apparently created the mock-up figure on page 8 of 8 – the same figure that was filed with the applications, is Donald Robinson an inventor? A declaration under 37 CFR 1.131 to swear behind a reference must normally be signed by each applicant. There are exceptions as provided by MPEP 715.04. Applicant will need to file a petition under 37 CFR 1.183 to the Office of Petitions in order to be granted a waiver for the signature of Mr. Shapiro. If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate. See MPEP 715.04(C). Examiner notes that a declaration has been made by Daniel Fossner signed 5/28/2009 and filed 5/29/2009 as a representative of the assignee. Yet no petition has been filed with the Office of Petitions for a waiver of Mr. Shapiro's signature.

8. With regard to Applicant's response on 08 July 2011, Applicant's remarks are not persuasive. The 1.131 declaration is ineffective as noted in Examiner's remarks below. Examiner addresses each of Applicant's remarks in the order they were presented in Applicant's response of 08 July 2011.

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9. Further in regard to § 1 paragraphs 1-3 of Applicant's response Applicant argues that the statement made, in paragraph 5 of the declaration, that the date of invention is prior to the date of Chamberlain is sufficient evidence of the date of the invention and that the date of the document is not relevant. Examiner notes that the declaration must state facts and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention. See MPEP 715.07 [R-3] below.

MPEP 715.07 [R-3] III. THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

- (A) > (actual)< reduction to practice of the invention prior to the effective date of the reference; or
- (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

Applicant has not shown a conception date coupled with due diligence from prior to the reference date (Chamberlain 60/231,298 9/8/2000) to the date of constructive reduction to practice (Daugherty et al 60/235,645 09/26/2000). Applicant statement of a conception date is not sufficient evidence to prove conception and due diligence prior to the reference date because actual dates of acts relied on to establish diligence must be provided. See MPEP 715.07 [R-3] below.

MPEP 715.07 [R-3] II. ESTABLISHMENT OF DATES

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration. When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not

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desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

Therefore, the declaration does not hold the evidence required to show conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

10. In regard to § 1 paragraphs 7-10 of Applicant's response, Applicant argues that it is not necessary to explain which portions of the evidence relate to each and every claimed feature of all claims and that the exhibit need not support all claims. However, in order to show conception, the Applicant must show possession of every feature such that one skilled in the art can reduce the invention to a practical form without "exercise of the inventive faculty" (see at least *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978)). Conception must be proved by corroborating evidence. See MPEP 2138.04 [R-5] below.

MPEP 2138.04 [R-5] Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986)

Applicant argues that paragraph 6 of the declaration includes a detailed comparison of how claim 1 relates to the exhibit. However, paragraph 6 details claim 1 of the application and how it relates to figure 3 of the application and not how it relates to the figure on page 3 of the exhibit. Further, applicant argues that the figure on page 3 of the exhibit is in material substance identical to Figure 3 of the application. However, several blocks that are referenced in paragraph 6 are missing from the figure on page 3 of the exhibit. Specifically, blocks 332 and 334 which represent the "retrieve user info" of figure 3 of the application is missing from the figure from page 3 of the

exhibit. Therefore, the figure on page 3 of the exhibit is not in material substance identical to Figure 3 of the application. Applicant further argues that each and every element of claim 1 is supported by the figure on page 3 of the exhibit, but the missing blocks (332 and 334) represent the receiving user information associated with a selectable option limitation of claim 1.

Applicant further argues that fact that evidence should be provided for all claims is not supported by any rule or law. However, applicant should refer to MPEP 715.07 [R-3] shown above. As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show: (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice). When establishing conception a party must show possession of every feature recited in the claim, and that every limitation of the claim must have been known to the inventor at the time of the alleged conception. Therefore, under 37 CFR 1.131(b) the applicant must first establish conception and prove that the inventor was in possession of every feature recited in the claim. (see MPEP 2138.04 [R-5] shown above) Next, the Applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131). To show due diligence the applicant must provide the actual dates of acts relied upon. (See MPEP 715.07 [R-3] shown above) Therefore Applicant's argument that there is no rule or law that the evidence must support all claims is not persuasive. As will be demonstrated below, Applicant's 1.131 declaration is deficient because it establishes neither conception nor due diligence.

11. In regard to § 2 of Applicant's response, Applicant argues that the evidence submitted is sufficient to establish conception. Examiner disagrees. In order to show conception, the Applicant must show possession of every feature recited in the claim, and that every limitation of the claim must

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have been known to the inventor at the time of the alleged conception. See MPEP 2138.04 [R-5] below.

MPEP 2138.04 [R-5] Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without “exercise of the inventive faculty.” *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986)

Applicant has submitted a declaration that was originally created on 8/31/2000 which is prior to the reference date (9/8/2000) but the last modified date (9/12/2000) is after the reference date. Applicant has not shown evidence that every limitation of the count was known to the inventor at the alleged time of conception. Additionally, as stated above, Applicant argues that paragraph 6 of the declaration provides a detailed comparison of how claim 1 relates to the exhibit of the declaration. However, paragraph 6 details claim 1 of the application and how it relates to figure 3 of the application and not how it relates to the figure on page 3 of the exhibit. Further, applicant argues that the figure on page 3 of the exhibit is in material substance identical to Figure 3 of the application. However, several blocks that are referenced in paragraph 6 are missing from the figure on page 3 of the exhibit. Specifically, blocks 332 and 334 which represent the “retrieve user info” of figure 3 of the application are missing from figure 3 of the exhibit. Therefore, the figure on page 3 of the exhibit is not in material substance identical to Figure 3 of the application. Applicant further argues that each and every element of claim 1 is supported by the figure on page 3 of the exhibit, but blocks (332 and 334) of figure 3 of the application represent the receiving user information associated with a selectable option limitation of claim 1, and these blocks are completely missing from the figure on page 3 of the exhibit. Therefore, each and every limitation of claim 1 is not represented by the figure on page 3 of the exhibit. For these reasons, applicant has not proven conception prior to the reference date.

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12. In regard to § 3 of Applicant's response, Applicant argues that the diligence demonstrated on 9/19/2000 is sufficient to demonstrate diligence for the entire six working days between 9/8/2000 and 9/19/2000. However, the entire period during which diligence is required must be accounted for. See MPEP 2138.06 [R-1] below. Specifically, In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) Applicant's statement that diligence on one day during the period demonstrates diligence for the entire period is not sufficient and applicant has not demonstrated diligence for the entire period during which diligence is required must be accounted for.

MPEP 2138.06 [R-1] "Reasonable Diligence" - THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES - An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959)

13. In regard to § 4 of Applicant's response, Applicant states that Daniel Fossner is not an inventor. Therefore Applicant admits that Daniel Fossner is not an inventor and that Applicant has not submitted a complete 1.131 declaration in which each inventor has participated and signed the declaration. Further Applicant's admission that Daniel Fossner is not an inventor demonstrates that the evidence submitted by Daniel Fossner cannot be relied on to demonstrate conception because Applicant admits that Mr. Fossner did not in fact conceive and invent the invention claimed herein. Therefore as noted above, the defective 1.131 declaration fails to establish conception.

Claim Rejections - 35 USC § 102 and § 103

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 1-10, 12, 17, 19, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chamberlain (US20030208369).**

Chamberlain includes benefit to provisional US application 60/231298 (filed 9/8/2000) and cited/included in a previous action. This action will refer to the disclosure as it appears in the 60/231298 provisional.

Regarding claims 1, 2, 4, 5, 9, 12, 17, 19, 20, Chamberlain teaches a website including a banner advertisement that includes user selectable fields. Each field is associated with an information delivery channel. The user may select email, FAX, mail, phone, etc. The user selects this field, provides his contact information (i.e. consents to information receipt at the indicated location) and the business will then provide further information about the advertisement/product over this channel to the requesting consumer [page 1 of provisional, figs 5,

8 of provisional]. Regarding the claim language concerning the sign-in procedure, Chamberlain teaches that the user may enter his channel-contact information each time he makes a request for information, or his contact-channel information can be part of a stored profile located at the server [provisional's page 7 middle paragraph, pg 9 lines 15-17, figure 7 (option 3)]. In this manner, the user does not have to continually type his various contact information (although he still can). It is taken to be inherent that in order for the system to access the proper stored profile for that particular user, the server would have to identify and authenticate that particular user according to some sign-in process. This then enables the user to specify a stored contact-channel delivery preference for that particular advertisement under consideration. Alternatively, it would have been obvious to one of ordinary skill at the time of the invention to have provided any well known sign-in procedure to identify and authenticate the user so that Chamberlain's server-store user profiles can be properly accessed.

Regarding claim 3, the information delivered provides an indication of the personal information used by way of the channel that the consumer gets the information.

Regarding claims 6-8, 10, providing a parcel/letter to the US Postal Service for example for delivery to the identified recipient is taken to be providing a third party with the personal/contact information of the consumer as well as an indication of the consumer's choice to have a postal delivery for them at that location.

Claims 11, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chamberlain in view of Patterson (US2003/0028608).

Regarding claims 11, 14-16, Patterson also teaches a user of a webpage filling out a text field with contact information so that the business who is advertising can contact that consumer through the specified communication channel and unique communication address provided [para 0026]. Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a confirmation notice that the

information will be provided via the communication channel, such as for example by third party US Postal Service.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

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[NOTE: the following is a repeat of previous rejections as alternative rejections]

17. **Claims 1-10, 12, 17, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg (US6330243).**

Regarding claims 1, 2, 4, 17, 19, 20, Stranberg teaches that it is well known for consumers to request product information from a business via the World Wide Web and for the business to provide a field for the inquiring party to provide a telephone number where they can be contacted for further information and follow-up [col 1: lines 28-46]. Stranberg also teaches the concept of a user accessing a webpage from a website via a web browser where the webpage can include various content such as text, images, audio, video, etc. as well as an HTML-based user interface with data entry capability. The HTML interface serves to advertise that more information about a product/service is available upon request and is therefore taken to meet the broad term "advertisement" as well as the term "item" [col 5: lines 7-8, lines 16-35]. The data entry fields of the interface are designed to elicit responses to requests for product information as is well known in the art" [5:24-26]. Such requests can include name, telephone, address, information desired, product inquiries or any other information useful for sales and/or marketing purposes [5:27-31]. While Stranberg admits it is known to contact an inquiring consumer via a submitted telephone number in order to provide the requested product information, Stranberg is silent on whether to contact the inquiring consumer according to the other collected information fields such as address. However, It would have been obvious to one of ordinary skill at the time of the invention to have provided any number of plural contact field options (postal mail, FAX, telephone, cell

phone, email, etc. as they are well known methods of communication – and in some cases, *electronic* communication), to have collected the appropriate number, address, email, etc. and to have contacted the inquiring party by such requested communication channels in order to deliver the desired product information. Doing so would allow consumers to receive the requested information in a format they find most comfortable, digestible and convenient – including an *electronic* delivery transmission method. Each of the plural fillable fields of Stranberg's interface is taken to represent a “selectable” option. Regarding the claim language concerning the sign-in procedure, Strandberg teaches that the system includes a user database [7:34] and that the system logs all of the information exchanged [8:33-35] and that the user database can store user name, address, telephone; and the system allows a record of those users who inquired further about their products or services [8:36-45]. It is taken to be inherent that in order for the system to access the proper user record in the database, the server would have to identify and authenticate that particular user according to some sign-in process. Alternatively, it would have been obvious to one of ordinary skill at the time of the invention to have provided any well known sign-in procedure to identify and authenticate the user so that the proper user record in the user database can be accessed.

Regarding claim 3, receiving a FAX, email, telephone call, postal mailing, etc inherently represents receiving an indication of personal information used to make such communication contact.

Regarding claims 5, 9, any of the received information about the consumer is taken to be personal information.

Regarding claims 6-8, 10, providing a parcel/letter to the US Postal Service for example for delivery to the identified recipient is taken to be providing a third party with the personal/contact information of the consumer as well as an indication of the consumer's choice to have a postal delivery for them.

Regarding claim 12, it would have been obvious to one of ordinary skill at the time of the invention to have asked for consent to send future communications to the consumer in order to

deliver future promotional materials as is well known. Doing so would serve to create a long-term relationship with the consumer.

18. **Claims 11, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg as above and further in view of Patterson (US2003/0028608).**

Regarding claims 11, 14-16, Patterson also teaches a user of a webpage filling out a text field with contact information so that the business who is advertising can contact that consumer through the specified communication channel and unique communication address provided [para 0026]. Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a confirmation notice that the information will be provided via the communication channel, such as for example by third party US Postal Service.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

19. **Claims 6, 10, 11, 13-16 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg in view of Patterson as above and/or over Patterson in view of Stranberg.**

Regarding claims 6, 10, Patterson teaches that a consumer (i.e. first party) can visit a first website (i.e. second party) which can include not only content about the first business, but also a banner advertisement from a second business (i.e. third party). The advertisement is taught to include a request form that the user can fill out such as "send me information on golf clubs" [para 0026]. The form can collect the user's email address as contact information as well as userID [para 0037]. It would have been obvious to one of ordinary skill at the time of the invention to have provided the plurality of contact options in a manner made obvious by Stranberg with the

third party advertisement of Patterson. Doing so would enable web surfers at many various websites to see and request the product information of Stranberg; this provides wider exposure for the third party. A consumer filling out a particular selectable option with his personal contact information results in an indication to the third party of the consumer's desire for information and the requested delivery channel and would trigger the delivery of such information via the proper communication channel (email, telephone, FAX, postal mail, etc.).

Regarding claims 11, 14-16, Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028, figure 4]. This message serves to indicate that the third party will be delivering the requested information.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1, 3-10 and 12 are rejected under 35 U.S.C.102(b) as being anticipated by Ingram et al. (U.S. 7,076,743 B2).

Claim 1

Ingram, as shown, discloses the following limitation:

- *utilizing at least one computer system for serving an advertisement associated with a first World Wide Web site*, (see figure 2 and col 4 lines 2 -4 Ingram discloses a banner advertisement on a webpage with a toolbar of user selectable options.)

- *wherein said advertisement has a plurality of associated selectable options that are displayed when said advertisement is displayed*, (see figure 2 and col 5 lines 50-60 Ingram discloses a toolbar associated with an advertisement which allows the user to select from multiple display options including; contact me later, send reminder, check out later, email me, more ads, and expand view. Examiner notes that while art has been applied to the limitation, the limitation as claimed does not have patentable weight because it describes the advertisement but does not further limit the utilizing step.)
- *further wherein each of said plurality of selectable options has an associated information delivery process*, (see figures 2 and 4 Ingram discloses several ways for the user to select to have the information delivered for example, see col 4 "When the user decides to select one of the enhanced link features, flow moves through that function's starting block (610 for Open in a New Window, 620 for Open in New Window Minimized, 630 for Check it Later, and 640 for Anchor Current Page)." and col 10 where Ingram discloses additional features "Capture the Hyperlinked Pages for Later Viewing, E-mail More Information" and "sweepstakes Information". Examiner notes that while art has been applied to the limitation, the limitation as claimed does not have patentable weight because it describes the advertisement but does not further limit the utilizing step.)
- *wherein the associated information delivery process differs for each of said plurality of selectable options*; (see figures 2 and 4 Ingram discloses several ways for the user to select to have the information delivered for example, see col 4 "When the user decides to select one of the enhanced link features, flow moves through that function's starting block (610 for Open in a New Window, 620 for Open in New Window Minimized, 630 for Check it Later, and 640 for Anchor Current Page)." and col 10 where Ingram discloses additional features "Capture the Hyperlinked Pages for Later Viewing, E-mail More Information" and "sweepstakes Information". Examiner notes that while art has been applied to the limitation, the limitation

as claimed does not have patentable weight because it describes the advertisement but does not further limit the utilizing step.)

- *utilizing the computer system for receiving user information associated with a selectable option;* (see col 10 lines 23-26 Ingram discloses the receiving a users email address.)
- *utilizing the computer system for receiving an indication of a user-selection of one of said plurality of selectable options associated with said advertisement;* (see at least col 8 lines 26-30 Ingram discloses the computer system receiving an indication of a user clicking on a selection.)
- *utilizing the computer system for providing information associated with said advertisement via said information delivery process associated with the selected one of said plurality of selectable options to a location based on the user information.* (see col 6 lines 19-23 Ingram discloses that when the user selects the “open in a new window” option the browser displays the information associated with the hyperlink in a new browser window.)

Claim 3:

Ingram, as shown, discloses the following limitation:

- *receiving an indication of personal information used during said providing information associated with said advertisement via said information delivery process.* (see col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email with more information about the advertisement that they expressed interest in. Examiner interprets the user receiving the email as the indication.)

Claim 4:

Ingram, as shown, discloses the following limitation:

- *where said providing information associated with said advertisement via said information delivery process includes at least one of the following: redirecting a browser to a second*

World Wide Web site containing said information; providing a hyperlink to a second World Wide Web site, wherein said second World Wide Web site contains said information; emailing said information; serving said information as part of a new advertisement associated with said first World Wide Web site; serving said information as part of said World Wide Web site; facsimileing said information; and mailing said information to a postal address. (see figure 2 and col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email with more information about the advertisement that they expressed interest in.)

Claim 5:

Ingram, as shown, discloses the following limitation:

- *wherein said indication of a selection of said selectable option associated with said advertisement is received from a user accessing said first World Wide Web site and further comprising: utilizing the computer system for determining personal information associated with said user. (see figure 2 and col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email with more information about the advertisement that they expressed interest in. Examiner interprets the email address is the personal information.)*

Claim 6:

Ingram, as shown, discloses the following limitation:

- *utilizing the computer system for providing at least a portion of said personal information associated with said user to a third party. (see figure 2 and col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email from the advertiser with more information about the advertisement that they expressed interest in. Examiner interprets the advertiser sending the information is the third party.)*

Claim 7:

Ingram, as shown, discloses the following limitation:

- *wherein providing information associated with said advertisement via said information delivery process is based at least in part on said personal information.* (see figure 2 and col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email from the advertiser with more information about the advertisement that they expressed interest in. Examiner interprets the email address is the users personal information.)

Claim 8:

Ingram, as shown, discloses the following limitation:

- *wherein said personal information includes at least one of the following: an email address; a postal address; an age; a telephone number; a facsimile number; a user preference; a credit card number; and a user identifier.* (see figure 2 and col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email from the advertiser with more information about the advertisement that they expressed interest in.)

Claim 9:

Ingram, as shown, discloses the following limitation:

- *wherein said determining personal information associated with said user includes: receiving an indication of said personal information associated with said user.* (see col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email with more information about the advertisement that they expressed interest in. Examiner interprets the user receiving the email as the indication.)

Claim 10:

Ingram, as shown, discloses the following limitation:

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- utilizing the computer system for providing an indication of said selection of said selectable option to a third party. (see col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email from the advertiser with more information about the advertisement that they expressed interest in.)

Claim 12:

Ingram, as shown, discloses the following limitations:

- *wherein said information associated with said advertisement includes a request for consent to receive additional information.* (see col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email with more information about the advertisement that they expressed interest in. Examiner interprets the option “e-mail me more information” as a request for consent to receive additional information.)

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
24. Claims 2, 11, 13-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram et al. (U.S. 7,076,743 B2) in view of Aronin (US 6,454,650 B1).

Claim 2:

Although Ingram, as shown above, discloses an banner advertisement with multiple options for selecting how to receive more information including displaying information on the advertisers website in a new browser window (see at least col 9 lines 34-39), entering an email address and submitting sweepstakes entry information (see col 10 lines 1-35), Ingram does not specifically disclose a user sign-in. However, Aronin, as shown, discloses the following limitations:

- *utilizing the computer system for determining whether a user at the user computer system has signed in* (see figure 3 and col 7 lines 28 – 39 Aronin discloses determining if the user is logged in.)
- *utilizing the computer system for displaying a sign-in page if the user has not signed in before providing the information associated with the said advertisement.* (see figure 3 Aronin discloses determining if the user is signed –in (see at least col 8 lines 13-14) and displaying the advertisers information based on the banner clicked after the sign-in determination. (see at least col 8 lines 39-45)
- *utilizing the computer system for receiving input from the user identifying where the information is to be sent the input depending on the selection made in (ii) following display of the sign-in page.* (see fig 2C Aronin discloses the address information collected is necessary for sending the lottery prize and see col 6 lines 60 – 63 “a new lottery participant is asked to enter certain relevant personal information such as the participant's first and last names, address and E-mail address. Additionally, the participant is also asked to select a log-in identification and password for future visits.”)

It would be obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the sign-in and collection address information of Aronin with the invention of Ingram because both inventions provide banner advertisements to users with multiple delivery options for advertiser information. Ingram discloses a sweepstakes entry option and Aronin discloses that it is necessary to have the user sign-in and provide address information in order know where to send the prize money (see figure 2C). The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 11:

Although Ingram, as shown above, discloses an banner advertisement with multiple options for selecting how to receive more information from third parties including displaying information on the advertisers website in a new browser window (see at least col 9 lines 34-39), entering an email address and submitting sweepstakes entry information (see col 10 lines 1-35), Ingram does not specifically disclose a notice that additional information will be provided by a third party. However, Aronin, as shown, discloses the following limitations:

- *providing a notice that additional information will be provided by a third party.* (see figure 2C Arinon discloses that users must read and agree to the rules of the FreeLotto and in col 2 lines 50-61 Arinon discloses that in order to participate in the lottery, customers must agree to receive information about products and services of third party advertisers. Examiner notes that providing when interpreted broadly is to be made available. Therefore, examiner interprets that the statement of agreement is notice.)

It would be obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the notice of third party information of Arinon with the invention of Ingram because both inventions disclose that banner advertisements paid for by third parties that may

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provide additional information to the user (Ingram col 5 lines 46-49 and Arinon col 2 lines 50-61). The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 13:

The combination of Ingram/ Arinon, as shown, discloses the limitation as shown in the rejection above.

However, Ingram, as shown, discloses the following limitations:

- *utilizing the computer system for receiving an indication of a consent to receive said additional information.* (see col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email with more information about the advertisement that they expressed interest in. Examiner interprets the user entering their email address is an indication of consent to receive additional information.)

Claim 14:

The combination of Ingram/ Arinon, as shown, discloses the limitation as shown in the rejection above.

However, Ingram, as shown, discloses the following limitations:

- *utilizing the computer system for providing said additional information.* (see col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email with more information about the advertisement that they expressed interest in.)

Claim 15:

Although Ingram, as shown above, discloses an banner advertisement with multiple options for selecting how to receive more information from third parties including displaying information on the advertisers website in a new browser window (see at least col 9 lines 34-39), entering an

email address and submitting sweepstakes entry information (see col 10 lines 1-35), Ingram does not specifically disclose a notice that additional information will be provided by a third party. However, Aronin, as shown, discloses the following limitations:

- *utilizing the computer system for providing a notice that additional information will be provided by a third party.* (see figure 2C Arinon discloses that users must read and agree to the rules of the FreeLotto and in col 2 lines 50-61 Arinon discloses that in order to participate in the lottery, customers must agree to receive information about products and services of third party advertisers. Examiner notes that providing when interpreted broadly is to be made available. Therefore, examiner interprets that the user is agreeing to a notice that has been provided.)

It would be obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the notice of third party information of Arinon with the invention of Ingram because both inventions disclose that banner advertisements paid for by third parties that may provide additional information to the user (Ingram col 5 lines 46-49 and Arinon col 2 lines 50-61). The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 16:

The combination of Ingram/ Arinon, as shown, discloses the limitation as shown in the rejection above.

However, Ingram, as shown, discloses the following limitations:

- *wherein said information associated with said advertisement includes a request for consent to receive additional information* (see col 10 lines 22-25 Ingram discloses prompting for an email address and the user receiving an email with more information about the advertisement that they expressed interest in. Examiner interprets the option "e-mail me more information" as a request for consent to receive additional information.)

Although Ingram, as shown above, discloses an banner advertisement with multiple options for selecting how to receive more information from third parties including entering an email address (see col 10 lines 22-27), Ingram does not specifically disclose a notice that additional information will be provided by a third party. However, Arinon, as shown, discloses the following limitations:

- *and a notice that said additional information will be provided by a third party.* (see figure 2C Arinon discloses that users must read and agree to the rules of the FreeLotto and in col 2 lines 50-61 Arinon discloses that in order to participate in the lottery, customers must agree to receive information about products and services of third party advertisers. Examiner notes that providing when interpreted broadly is to be made available. Therefore, examiner interprets that the user is agreeing to a notice that has been provided.)

It would be obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the notice of third party information of Arinon with the invention of Ingram because both inventions disclose that banner advertisements paid for by third parties that may provide additional information to the user (Ingram col 5 lines 46-49 and Arinon col 2 lines 50-61). The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 17

Ingram, as shown, discloses the following limitation:

- utilizing at least one computer system for serving a displayable item associated with a World Wide Web site, (see figure 2 and col 4 lines 2 -4 Ingram discloses a banner advertisement on a webpage with a toolbar of user selectable options.)
- *wherein said displayable item has at least two associated selectable options and each of said two selectable options has a different associated information delivery process;* (see figures 2 and 4 Ingram discloses several ways for the user to select to have the information delivered

for example, see col 4 “When the user decides to select one of the enhanced link features, flow moves through that function's starting block (610 for Open in a New Window, 620 for Open in New Window Minimized, 630 for Check it Later, and 640 for Anchor Current Page).” and col 10 where Ingram discloses additional features “Capture the Hyperlinked Pages for Later Viewing, E-mail More Information” and “sweepstakes Information”. Examiner notes that while art has been applied to the limitation, the limitation as claimed does not have patentable weight because it describes the displaying item but does not further limit the utilizing step.)

- *utilizing the computer system for receiving user information associated with a selectable option;* (see col 10 lines 23-26 Ingram discloses the receiving a users email address.)
- *utilizing the computer system for receiving an indication of a user-selected one of said at least two selectable options;* (see at least col 8 lines 26-30 Ingram discloses the computer system receiving an indication of a user clicking on a selection.)
- *utilizing the computer system for providing information associated with said advertisement via said information delivery process associated with the selected one of said plurality of selectable options to a location based on the user information.* (see col 6 lines 19-23 Ingram discloses that when the user selects the “open in a new window” option the browser displays the information associated with the hyperlink in a new browser window.)

Although Ingram, as shown above, discloses an banner advertisement with multiple options for selecting how to receive more information including displaying information on the advertisers website in a new browser window (see at least col 9 lines 34-39), entering an email address and submitting sweepstakes entry information (see col 10 lines 1-35), Ingram does not specifically disclose a user sign-in. However, Aronin, as shown, discloses the following limitations:

- *utilizing the computer system for determining whether a user has signed in;* (see figure 3 and col 7 lines 28 – 39 Aronin discloses determining if the user is logged in.)

It would be obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the sign-in and collection address information of Aronin with the invention of Ingram because both inventions provide banner advertisements to users with multiple delivery

options for advertiser information. Ingram discloses a sweepstakes entry option and Aronin discloses that it is necessary to have the user sign-in and provide address information in order know where to send the prize money (see figure 2C). The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 19:

The combination of Ingram/ Arinon, as shown, discloses the limitation as shown in the rejection above.

Although Ingram, as shown above, discloses an banner advertisement with multiple options for selecting how to receive more information including displaying information on the advertisers website in a new browser window (see at least col 9 lines 34-39), entering an email address and submitting sweepstakes entry information (see col 10 lines 1-35), Ingram does not specifically disclose a user sign-in. However, Aronin, as shown, discloses the following limitations:

- *utilizing the computer system for receiving input from the user identifying where the information is to be sent the input depending on the selection made in (ii) following display of the sign-in page.* (see fig 2C Aronin discloses the address information collected is necessary for sending the lottery prize and see col 6 lines 60 – 63 “a new lottery participant is asked to enter certain relevant personal information such as the participant's first and last names, address and E-mail address. Additionally, the participant is also asked to select a log-in identification and password for future visits.”)

It would be obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the sign-in and collection address information of Aronin with the invention of Ingram because both inventions provide banner advertisements to users with multiple delivery options for advertiser information. Ingram discloses a sweepstakes entry option and Aronin

discloses that it is necessary to have the user sign-in and provide address information in order know where to send the prize money (see figure 2C). The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 20:

The combination of Ingram/ Arinon, as shown, discloses the limitation as shown in the rejection above.

However, Ingram, as shown, discloses the following limitations:

- *wherein said displayable item includes at least one of the following: an image; a hyperlink associated with at least one of said two selectable options; a banner; a button; and a badge.* (see figure 2 and col 2 lines 28-36 Ingram discloses a banner advertisement with a toolbar for selecting among multiple options for delivery of more information pertaining to the advertisement.)

Response to Arguments

25. **Re: 35 USC § 102 and § 103 rejection in view of Chamberlain, Chamberlain in view of Patterson and Strandberg.**

Applicant argues that Chamberlain is not prior art. This is insufficient for at least the reasons stated in the section titled *37 CFR 1.131 Declaration* above.

In response to applicant's argument that Strandberg is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Applicant argues that Strandberg is not related

to advertisements. Examiner disagrees. Strandberg teaches soliciting for users to request more product information. These are advertisements for and about the product. Therefore, Strandberg is analogous art.

Applicant argues that Strandberg fails to teach a selectable option of claim 1. Examiner disagrees. Examiner firmly believes that one of ordinary skill would recognize a fillable field as a means for a customer to select how he can be contacted for more information about a product. Receipt of this information provides not only the information but provide an indication that a selection was made by the consumer.

Applicant argues the date that examiner applied a reference as being somehow an indication of hindsight. Examiner disagrees. First, this argument is not persuasive and the date the art was applied to the reference bares no relevance to the rejection. Second, the rejection is made as to what would have been obvious at the time of the invention. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

26. **Re: 35 USC § 102 and § 103 rejection in view of Ingram, Ingram in view of Aronin.**

With respect to the 35 USC § 102 and § 103 rejection of claims 1-17 and 19-20 in view of Ingram, Ingram in view of Aronin, Applicant has neither amended the claims nor rebutted Examiners interpretation of the limitations of the claims. Examiner interprets Applicant's silence as acceptance of Examiner's rejection. Therefore, the rejection is maintained and made final.

Conclusion

27. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
28. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
29. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Patricia Munson** whose telephone number is **571.270.5396**. The Examiner can normally be reached on Monday-Friday, 5:30am-2:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6805**.
30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
31. Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark**

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